No. 15-777

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IN THE

Supreme Court of the United States

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS AMERICA, INC., SAMSUNG TELECOMMUNICATIONS AMERICA LLC,

Petitioners,

v.

APPLE INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

1. Whether the court of appeals correctly ruled that the district court did not commit reversible error in instructing the jury regarding the scope of Apple's design patent claims.

2. Whether 35 U.S.C. § 289, which provides that a party that infringes a design patent may be held "liable ... to the extent of his total profit," permitted the jury to award damages equal to Samsung's total profit from its devices that infringed Apple's design patents.

CORPORATE DISCLOSURE STATEMENT

Respondent Apple Inc. has no parent corporation. To the best of Apple's knowledge and belief, and based on public filings with the Securities and Exchange Commission, as of February 3, 2016, no publicly held corporation owns 10% or more of Apple's stock.

TABLE OF CONTENTS

Page

QUESTIONS PRESENTED i

TABLE OF AUTHORITIES v

INTRODUCTION 1

STATEMENT 3

A. The Design Patent System 3

B. Apple's Iconic iPhone Designs And Samsung's Infringement 5

C. Proceedings Below 12

REASONS FOR DENYING THE PETITION 13

I. THE FEDERAL CIRCUIT'S RULING ON DESIGN PATENT INFRINGEMENT DOES NOT MERIT THIS COURT'S REVIEW 13

A. Samsung's Design Patent Infringement Arguments Do Not Warrant Certiorari 14

B. This Case Is A Poor Vehicle To Address Design Patent Infringement In Any Event 23

II. THE FEDERAL CIRCUIT'S RULING ON DESIGN PATENT DAMAGES DOES NOT MERIT THIS COURT'S REVIEW 25

A. The Federal Circuit's Ruling Is Fully Consistent With § 289's Text, Legislative History, And Longstanding Judicial Interpretation 25

TABLE OF CONTENTS—Continued

Page

B. Samsung Identifies No Reason To Depart From § 289's Clear And Settled Meaning 28

1. There is no circuit split 28

2. Samsung's analogies to other legal contexts are inapt 32

III. THIS CASE DOES NOT PRESENT AN IMPORTANT QUESTION REQUIRING THIS COURT'S RESOLUTION 34

CONCLUSION 38

TABLE OF AUTHORITIES

CASES

Page(s)

Advanced Magnetic Closures, Inc. v. *Rome Fastener Corp.*, 607 F.3d 817 (Fed. Cir. 2010) 24

Aro Manufacturing Co. v. *Convertible Top Replacement Co.*, 377 U.S. 476 (1964) 5

Bergstrom v. *Sears, Roebuck & Co.*, 496 F. Supp. 476 (D. Minn. 1980) 25

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Bonito Boats, Inc. v. *Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989) 4, 20, 37

Bush & Lane Piano Co. v. *Becker Bros.*, 222 F. 902 (2d Cir. 1915) 30, 31

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TABLE OF AUTHORITIES—Continued

Page(s)

Egyptian Goddess, Inc. v. *Swisa, Inc.*, 543 F.3d 665 (Fed. Cir. 2008) 21, 22, 23

Ethicon Endo-Surgery, Inc. v. *Covidien, Inc.*, 796 F.3d 1312 (Fed. Cir. 2015) 4, 17, 20

Gorham Co. v. *White*, 81 U.S. (14 Wall.) 511 (1872) 3, 4, 21

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Kansas v. *Marsh*, 548 U.S. 163 (2006) 14

L.A. Gear, Inc. v. *Thom McAn Shoe Co.*, 988 F.2d 1117 (Fed. Cir. 1993) 4

Lee v. *Dayton-Hudson Corp.*, 838 F.2d 1186 (Fed. Cir. 1988) 18

Markman v. *Westview Instruments, Inc.*, 517 U.S. 370 (1996) 22, 24

Meyer v. *Holley*, 537 U.S. 280 (2003) 25

Microsoft Corp. v. *AT&T Corp.*, 550 U.S. 437 (2007) 37

NCAA v. *Smith*, 525 U.S. 459 (1999) 25

Nike, Inc. v. *Wal-Mart Stores, Inc.*, 138 F.3d 1437 (Fed. Cir. 1998) ..... *passim*

TABLE OF AUTHORITIES—Continued

Page(s)

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Sheldon v. *Metro-Goldwyn Pictures Corp.*, 309 U.S. 390 (1940) 32, 33

Spring Co. v. *Edgar*, 99 U.S. 645 (1879) 14

Teva Pharmaceuticals USA, Inc. v. *Sandoz Inc.*, 135 S. Ct. 831 (2015) 22

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Trans-World Manufacturing Corp. v. *Al Nyman & Sons, Inc.*, 750 F.2d 1552 (Fed. Cir. 1984) 26, 27

United States v. *Snow*, 462 F.3d 55 (2d Cir. 2006) 31

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Warner-Jenkinson Co. v. *Hilton Davis Chemical Co.*, 520 U.S. 17 (1997) 4

Young v. *Grand Rapids Refrigerator Co.*, 268 F. 966 (6th Cir. 1920) 31

TABLE OF AUTHORITIES—Continued

Page(s)

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Apple Inc. v. *Samsung Electronics Co.*, No. 2013-1129 (Fed. Cir.) 35

Apple Inc. v. *Samsung Electronics Co.*, No. 2014-1802 (Fed. Cir.) 2

Microsoft Corp. v. *Corel Corp.*, No. 15-cv-5836 (N.D. Cal.) 36

Skechers U.S.A., Inc. v. *DB Shoe Co.*, No. 14-cv-7009 (C.D. Cal.) 36

STATUTES AND LEGISLATIVE MATERIALS

35 U.S.C.
§ 171(a) 3
§ 289 ..... *passim*

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BRIEF IN OPPOSITION

INTRODUCTION

Before 2007, mobile phones were bulky, inelegantly designed boxes with multiple buttons and protruding antennas. Apple invested billions of dollars and devoted several years' work by its designers and engineers to develop the iPhone, which revolutionized the market. The iPhone's explosive success was due in no small part to its innovative design, which included a distinctive front face and a colorful graphical user interface—features protected by U.S. design patents.

The innovation and beauty of Apple's designs were not only hailed by consumers and the press, but envied by Apple's fiercest competitor Samsung, which by its executive's own admission in related litigation is a "fast follower" rather than an innovator.[1] Faced with what its leadership called a "crisis of design," CAJA25349, Samsung made a deliberate and conscious decision to copy the iPhone's innovative look and many of its other features, and its mobile devices became iPhone clones. The jury, the district court, and the Federal Circuit all recognized that Samsung infringed Apple's design patents. Indeed, Samsung did not even call a non-infringement expert to testify about the design patents at trial, nor did it appeal the jury's finding that Apple's design patents are valid.

Samsung's effort to make this case seem certworthy depends on a made-up narrative in which Samsung, not Apple, is the innovator, despite the overwhelming evidence that Samsung copied the iPhone's innovative design. Samsung also invites the Court to consider this case not based on the record, but based on blog posts, unsupported factual assertions, and evidence excluded as a discovery sanction. Once Samsung's diversions are swept aside as they should be, the actual issues it presents do not deserve review. The decisions below broke no new legal ground; they simply applied the statute and well-settled law to the extraordinary record of infringement and copying in this case.

Samsung's petition for certiorari should be denied.

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[1] JA11702-11704, Dkt. 92, No. 2014-1802, *Apple Inc.* v. *Samsung Elecs. Co.* (Fed. Cir. Jan. 12, 2015).

STATEMENT

A. The Design Patent System

While utility patents protect functional inventions and copyrights protect works of art, design patents protect designs applied to or incorporated within functional objects. *See* 35 U.S.C. § 171(a) (providing protection for "any new, original and ornamental design for an article of manufacture"); *In re Koehring*, 37 F.2d 421, 422 (C.C.P.A. 1930) ("[T]ools and mechanisms which are patentable because of their utilitarian qualities may also properly be the subject-matter for design patents."); 8 *Chisum on Patents* § 23.02 (2014) (Congress created design patents in 1842 to "fill a gap between copyright protection for authors and patent protection for inventors in the mechanical arts").

In authorizing design patents, Congress "manifestly contemplate[d] that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it and may be a meritorious service to the public." *Gorham Co.* v. *White*, 81 U.S. (14 Wall.) 511, 524-525 (1872); *see also* 18 Cong. Rec. 834 (1887) (House Committee on Patents) ("Property in original designs ... is ... of great and increasing value[and] intimately related to material progress in the industrial arts."). More broadly, "in basing a patent right upon the ornamentation or beauty of a tool or mechanical device, ... Congress expressed a desire to promote more beauty, grace, and ornamentation in things used, observed, and enjoyed by our people." *Koehring*, 37 F.2d at 422. In modern times, design patent protection is "especially important in the high-technology consumer goods sector because such high-technology is not often clearly demonstrable except through the goods' outer appearance, which is fre-

quently the target of copyists." Beebe, *Intellectual Property Law and the Sumptuary Code*, 123 Harv. L. Rev. 809, 863-864 (2010).

In light of their different statutory purpose, design patents "fundamentally differ[]" from utility patents, 8 *Chisum* § 23.01, with respect to what they protect, how they are infringed, and what remedies they carry. As this Court has noted, the validity analysis is different: "To qualify for protection, a design must present an aesthetically pleasing appearance that is not dictated by function alone, and must satisfy the other criteria of patentability." *Bonito Boats, Inc.* v. *Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989). The "dictated by function" validity test ensures that a party cannot patent a "design ... essential to the use of the article" that is more properly protected by a utility patent, while recognizing that a design is not unpatentable merely because the underlying "article of manufacture necessarily serves a utilitarian purpose." *L.A. Gear, Inc.* v. *Thom McAn Shoe Co.*, 988 F.2d 1117, 1123 (Fed. Cir. 1993). In other words, "in determining whether a claimed design is primarily functional, '[t]he function of the article itself must not be confused with "functionality" of the *design* of the article.'" *Ethicon Endo-Surgery, Inc.* v. *Covidien, Inc.*, 796 F.3d 1312, 1328 (Fed. Cir. 2015) (emphasis added).

The infringement analysis also differs. Whereas a utility patent is infringed if the accused product "contain[s] elements identical or equivalent to each claimed element of the patented invention," *Warner-Jenkinson Co.* v. *Hilton Davis Chem. Co.*, 520 U.S. 17, 40 (1997), a design patent is infringed if an "ordinary observer" considering purchasing the accused product would be deceived into thinking that it embodied the patented design, *Gorham*, 81 U.S. (14 Wall.) at 528.

The available remedies differ too. In 1887, Congress enacted the predecessor to 35 U.S.C. § 289, which permits a design patent holder to recover the "total profit" made on the infringing product. *Nike, Inc.* v. *Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1441-1442 (Fed. Cir. 1998) (citing Act of Feb. 4, 1887, ch. 105, § 1, 24 Stat. 387, 387). The House Committee on Patents explained that the rule "prevents the infringer from actually profiting by his infringement. The patentee recovers the profit actually made on the infringing article ... that is, what the infringer realized from the infringing articles minus what they cost him." 18 Cong. Rec. 834; *see also id.* ("[I]t is just[ice] that the entire profit on the article should be recoverable."). While a version of that remedy was once available for utility patent infringement as well, Congress eliminated it in 1946. *See Aro Mfg. Co.* v. *Convertible Top Replacement Co.*, 377 U.S. 476, 505-507 (1964) (citing Act of Aug. 1, 1946, ch. 726, § 1, 60 Stat. 778).

B. Apple's Iconic iPhone Designs And Samsung's Infringement

In 2007, Apple introduced the iPhone, revolutionizing the mobile phone market. Apple's designers worked "night[s]," "weekends"—"all the time"—to create a "new, original, and beautiful object, something that would really wow the world." CAJA40485; Dist. Ct. Dkt. 1610 at 745. Some observers initially questioned whether Apple would succeed, CAJA40601-40603, but the market soon recognized that Apple's new design was game-changing. As Time magazine recognized in choosing the iPhone as "Invention of the Year," one of Apple's "basic insights about technology is that good design is actually as important as good technology." CAJA27150. Unlike the buttons, knobs, and ugly

protrusions of prior phones, Apple's iPhone was smooth and elegant and earned immediate acclaim. *E.g.*, CAJA27141-27144 (New York Times) (iPhone design was "gorgeous" with a "shiny black [front face], rimmed by mirror-finish stainless steel" and a "spectacular" user interface), CAJA27145-27149 (Wall Street Journal) (iPhone design was "beautiful and [a] breakthrough," featuring a "clever finger-touch interface"). Samsung itself recognized the iPhone's potential for "[s]uccess" because of its "[b]eautiful design" and its "[ea]sy and intuitive [user interface]." CAJA25003. Samsung's conclusion was correct: The iPhone took the market by storm. CAJA40627-40628.

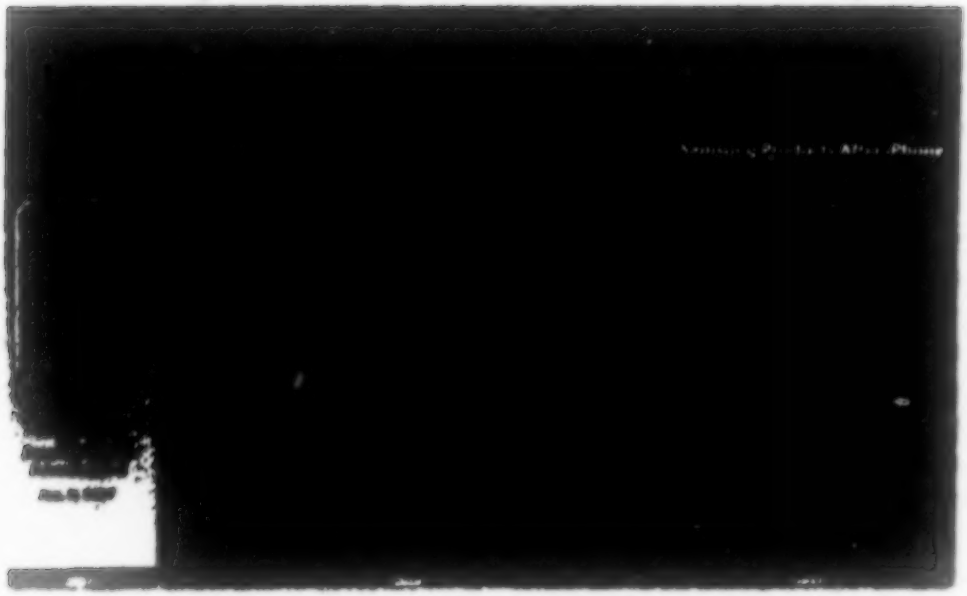
The three design patents at issue protect various aspects of the iPhone's iconic design. U.S. Design Patent No. 618,677 (the "D'677 patent") protects the iPhone's distinctive front face; U.S. Design Patent No. 593,087 (the "D'087 patent") protects the iPhone's distinctive overall appearance, including its particular shape, the flat contour of the front face, and the raised edge separating the glass display from the rest of the device; and U.S. Design Patent No. 604,305 (the "D'305 patent") protects the iPhone's colorful graphical user interface.

Although Samsung now tries to portray itself as an innovator (Pet. 7-8), Samsung acknowledged at the time that the iPhone's design was miles ahead of its own. *E.g.*, CAJA25174 ("Apple has overtaken Samsung as the most stylish brand overall."); CAJA25185 (Samsung noting that the iPhone set "the standard for screen-centric design"). As Samsung's mobile division head told its highest executives, Samsung faced a "crisis of design"—"when our [user experience] is compared to the unexpected competitor Apple's iPhone, the difference is truly that of Heaven and Earth."

CAJA25349; *see also* CAJA25346 ("When everybody (both consumers and the industry) talk about [user experience], they weigh it against the iPhone.").

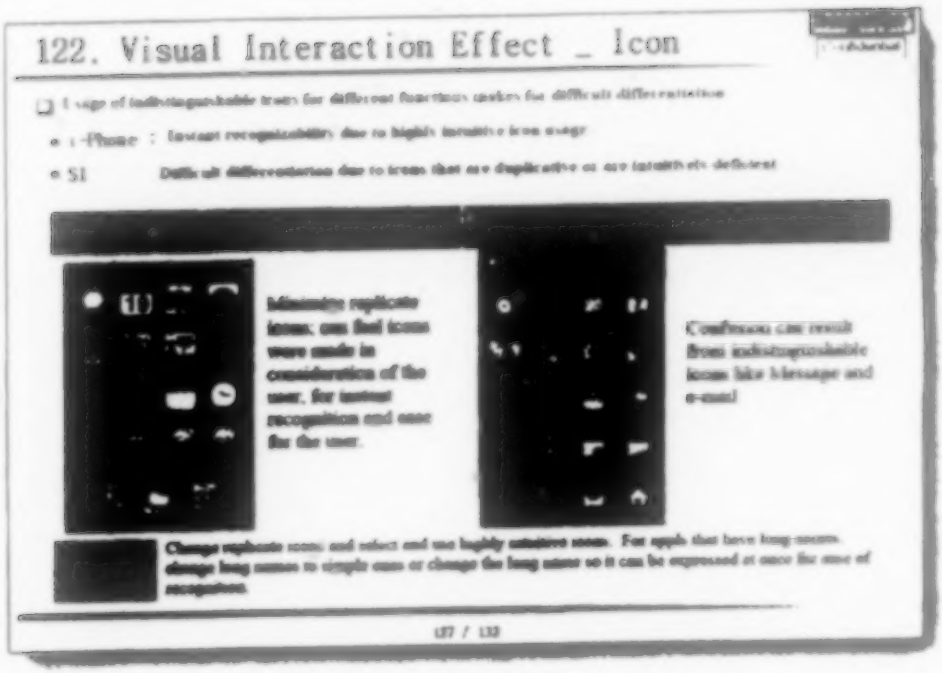
Rather than innovate, Samsung copied. *E.g.*, CAJA25487, 41414-41416. Before the iPhone, Samsung's mobile phones resembled walkie-talkie-like boxes with bulky antennas and keyboards, as the following trial demonstrative showed:

CAJA24679. After Apple announced the iPhone, Samsung's phones transformed—in only "three months" of design, CAJA42538-42539—into sleek, streamlined, narrow rectangles that mimicked the iPhone's distinctive appearance:



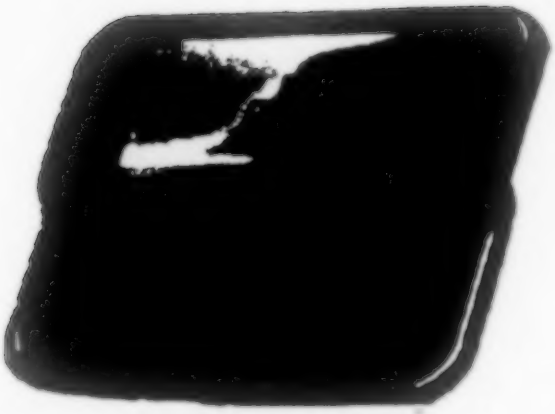
CAJA24681.

CAJA90143. As Apple's design expert testified, these similarities were "beyond coincidental," CAJA41409—they were intentional copying. This was confirmed at trial through Samsung's own documents, including the following comparison that included specific "[d]irections for [i]mprovement" to make Samsung's graphical user interface and icons more like Apple's:



CAJA25492. Samsung's copying extended to numerous distinctive aspects of Apple's user experience. *E.g.*, CAJA25408, 25416, 25423, 25487, 25496; *see also* Apple C.A. Br. 15-17.

Before this Court, Samsung (Pet. 8) tries to escape its adjudicated copying by pasting an image of its F700 design to support an argument that Samsung supposedly did not copy the iPhone. Although not shown in the image selected by Samsung, the F700 was an old-fashioned "slider" design with a slide-out keyboard:



Def. Ex. 2627 at 25. Samsung's suggestion that the F700 was a precursor to its infringing designs was not supported by any evidence. To the contrary, Samsung's lead designer testified that the infringing Samsung Galaxy S design was "his own independent one" and was *not* influenced by the F700. Dist. Ct. Dkt. 1648-5 at 7-8; *see also* CAJA6833 (district court noting that Samsung's F700 designer did not design any of Samsung's infringing devices and was unaware of any Samsung phone having been based on the F700 design). That is presumably why Samsung never disclosed the F700 during discovery as purported evidence of its own independent development and, consequently, why the district court sanctioned Samsung by forbidding use of the F700 to "rebut an allegation of copying"—a sanction upheld on appeal and not challenged in Samsung's petition. *See* CAJA6833; Dist. Ct. Dkt. 2708 at 2; Pet. App. 26a.[2]

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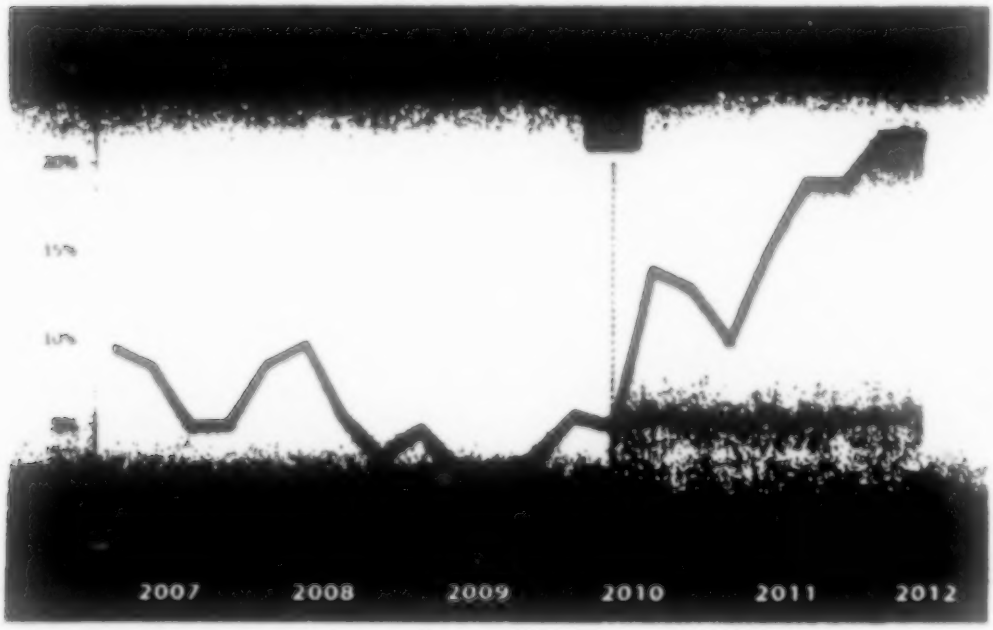
[2] Samsung's use (Pet. 7) of the Q-Bowl image is similarly inappropriate: that device was simply an earlier version of the F700, Dist. Ct. Dkt. 2708 at 2, and the district court accordingly precluded Samsung from using it to rebut copying as well, *compare* Dist. Ct. Dkt. 1441 at 2 (Apple objection to slides 11-19), *with* Dist. Ct. Dkt. 1456 at 2 (sustaining objection).

The only possible conclusion on this record is that Samsung blatantly copied the iPhone's design. That was certainly the market's conclusion. WIRED magazine observed that Samsung's design "is shockingly similar to the iPhone 3G: The rounded curves as the corners, the candybar shape, the glossy black finish and the chrome-colored metallic border around the display." CAJA24687 ("Samsung Vibrant Rips Off iPhone 3G Design"). And the Wall Street Journal explained that Samsung's Vibrant "has rounded corners and a prominent border that make it look very much like last year's iPhone 3GS model." CAJA24688.

Samsung's strategy worked. Samsung's share of the smartphone market swung "abrupt[ly] upward" following its copying, CAJA42050-42052—jumping from 5% to 20% in just two years—while Apple's market share fell, as the jury saw:



CAJA90104.

After unsuccessfully asking Samsung to stop copying Apple's designs, Apple brought this lawsuit.

C. Proceedings Below

At the 13-day trial, Samsung proffered no expert testimony suggesting that it did not infringe Apple's design patents. The jury found Apple's design patents valid and infringed and awarded damages, and the district court entered judgment in Apple's favor. Pet. App. 4a-5a.

The district court gave the jury detailed instructions regarding the features that Apple's patents did and did not protect, including when explaining how to determine design patent validity. *E.g.*, Pet. App. 164a ("If Samsung proves ... that the overall appearance of an Apple patented design is dictated by how the article claimed in the patent works, the ... design is not 'ornamental.'"). The court repeatedly instructed the jury that design patent claims covered only the "ornamental design." *E.g.*, *id.* 160a-161a. The court also instructed that, if the jury found infringement, it could (but was not required to) award Samsung's total profit on the infringing devices. *Id.* 165a ("[Y]ou *may* award Apple th[e] ... total profit attributable to the infringing products." (emphasis added)).[3]

Although Samsung appealed numerous issues, it did not challenge the validity of Apple's design patents. The Federal Circuit rejected each of Samsung's design-

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[3] Samsung quotes the jury instruction (Pet. 16-17) in a misleading manner. The instruction's first paragraph, quoted above, makes clear that the jury *may, but need not*, award total profits. Pet. App. 165a. The fourth paragraph, quoted by Samsung for the proposition that "Apple is entitled to all profit," merely lays out how to *calculate* total profit should the jury choose to award it. *Id.*

patent-related arguments. Pet. App. 19a-29a. Samsung's petition does not dispute many of the Federal Circuit's rulings, including that the district court correctly instructed the jury on the test for design patent infringement and on the extent to which the jury should consider prior art. *See id.* 23a-25a. Nor does Samsung deny that substantial evidence supported the jury's finding that Samsung infringed the D'677, D'087, and D'305 patents under the legal standards the Federal Circuit applied. *See id.* 25a-26a.

Rather, Samsung challenges only two rulings. First, the panel held that design patent infringement depended on the factfinder's review of the *overall* ornamental appearance of a design, even if the design applied to aspects of the phone that had some utilitarian purpose. Pet. App. 19a-23a. Second, the panel rejected Samsung's "quest" to avoid the text of § 289, which "explicitly authorizes the award of total profit." *Id.* 27a-29a. Samsung's desire to impose an "'apportionment' requirement" reflected an approach that "Congress rejected" as to design patents. *Id.* 27a.

The Federal Circuit denied rehearing without dissent. Pet. App. 154a-155a.

REASONS FOR DENYING THE PETITION

I. THE FEDERAL CIRCUIT'S RULING ON DESIGN PATENT INFRINGEMENT DOES NOT MERIT THIS COURT'S REVIEW

Samsung raises two issues relating to design patent infringement: (1) whether the district court sufficiently instructed the jury regarding the scope of Apple's design patents (Pet. 21-24); and (2) whether a district court *must* give the jury a detailed verbal description of a design patent claim (*id.* 24-25). Neither issue

merits review, and this case is not a good vehicle for either.

A. Samsung's Design Patent Infringement Arguments Do Not Warrant Certiorari

Samsung asserts that the district court erred in its construction of Apple's design patents, but it identifies no decision of this Court or even the Federal Circuit that directly supports its position.

1. Samsung contends (Pet. 21-24) that the district court should have done more to explain the protection provided by design patents. But Samsung fails to consider the district court's jury charge as a whole, which more than adequately explained the issue. *See Spring Co.* v. *Edgar*, 99 U.S. 645, 659 (1879) ("In examining the charges of the court for the purpose of ascertaining its correctness ... the whole scope and bearing of it must be taken together."); *see also Kansas* v. *Marsh*, 548 U.S. 163, 179 n.6 (2006) (discussing the "well-established proposition that a single instruction to a jury may not be judged in artificial isolation but must be viewed in the context of the overall charge"); 9C Wright & Miller, *Federal Practice & Procedure* § 2558 (3d ed. 2008) ("[I]n determining whether the charge is erroneous, ... the critical inquiry is whether the instructions, viewed in the aggregate, properly guided the jurors in their deliberations.").

The district court told the jury that a design is not "ornamental"—and thus not validly patentable—if its "overall appearance ... is dictated by how the article claimed in the patent works .... In other words, [a design is not ornamental if] in order to achieve the function of the design, it had to be designed that way." Pet. App. 164a. The jury was also given guidelines for

determining "whether a design is dictated by functionality" (*i.e.*, is not ornamental), including "whether there are any elements in the design or an overall appearance clearly not dictated by function." *Id.*; *see also id.* (jury could consider alternative designs, advertising, and other factors). The court also repeatedly stated that Apple's design patents protect only an article's "ornamental design." CAJA1390-1391 (the patents-in-suit each "claim[] the ornamental design"); CAJA1403 (design patent "cover[s]" "ornamental aspects"); CAJA40261 ("A design patent protects the ornamental design of an article of manufacture."). Taken as a whole—as it must be—the court's charge clearly informed the jury what aspects of Apple's design patents were and were not protected.[4]

Because the district court explained the proper legal standard, the question whether any particular feature of Apple's patented designs was dictated by function was a factual issue resolved against Samsung, which Samsung did not raise in its petition and would not warrant certiorari in any event. As Apple's witnesses testified, while *components* of the patented designs have some functionality, the way in which Apple *designed* those components was not dictated by their function because those same functions could be performed by numerous other designs. For example, the jury heard testimony that the "shape, location [and] size" of the iPhone's display screen "are not required by [its] functions." CAJA41201-41203; *see also* CAJA41093-

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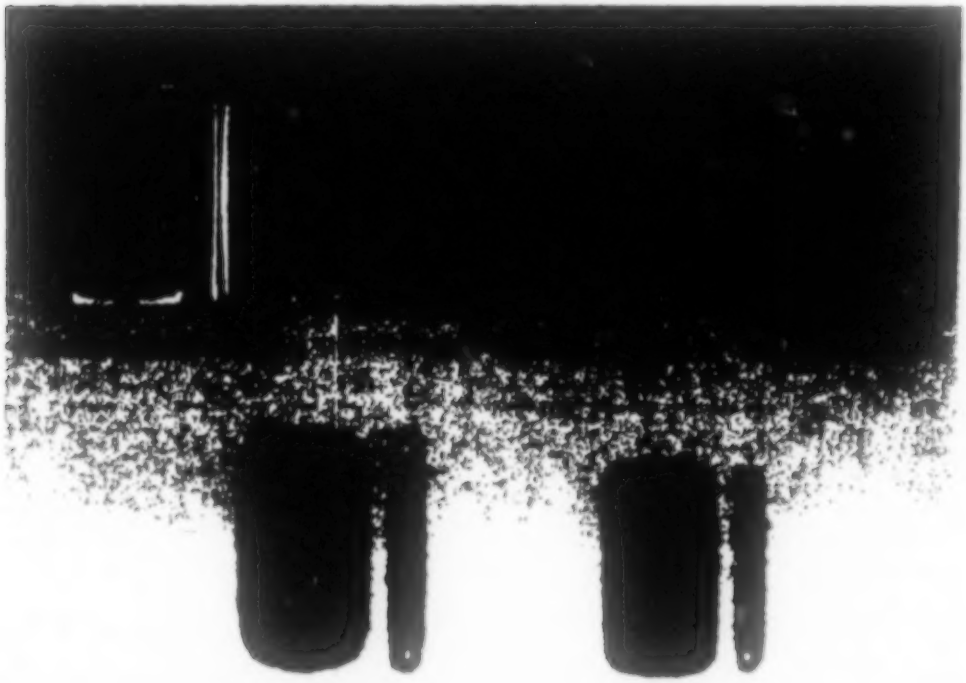
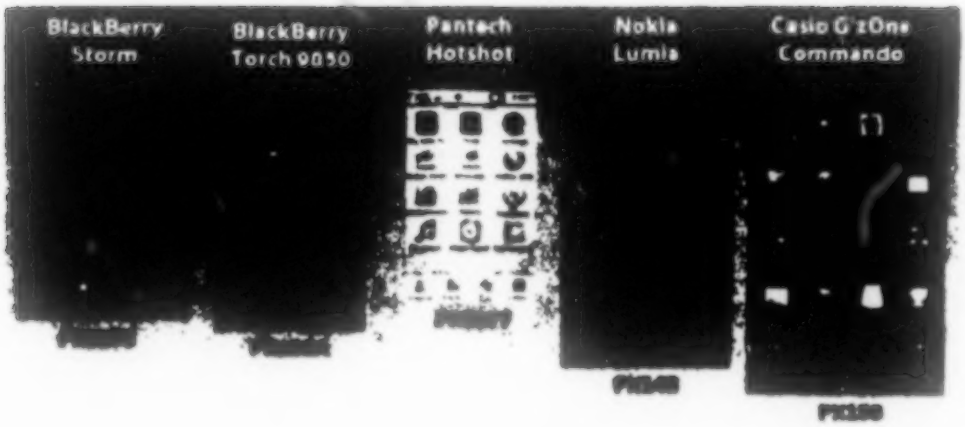
[4] Samsung's apparent view that design patent jury instructions are so radically different from other jury instructions as to require review in isolation, rather than as a whole, is exactly the sort of patent-specific categorical rule that this Court has disapproved. *E.g.*, *eBay, Inc.* v. *MercExchange, L.L.C.*, 547 U.S. 388, 393 (2006).

41094 (expert testimony that, in light of the number of available alternative designs, "none of the [claimed] elements" of the D'677 and D'087 patents (like corners with particular radii and a rectangle with a particular form factor) was "dictated by function").

Indeed, the jury saw several alternative, non-infringing designs for both the patented outer casing and the graphical user interface, which demonstrate that one can easily design a functioning smartphone without copying Apple's designs:





CAJA24767; *see also* CAJA27203-27204, 27206, 27476-27477 (physical exhibits).

Samsung's assertion (Pet. 22) that Apple's design patents improperly claim "conceptual or functional attributes like rounded corners and rectangular form" is simply wrong and, in any event, shows no error in the jury instructions. The jury understood that abstract forms and concepts themselves are not patentable. *E.g.*, Pet. App. 160a (instruction stating that "[t]he scope of the [design patent] claim ... does not cover a general design concept, and it is not limited to isolated features of the drawings"). Rather, Apple's patents protect designs that *incorporate*, but are not limited to, individual shapes and colors—just as one might patent a rug design with a zigzag or floral pattern without claiming an intellectual property right to prevent others from using zigzag lines or flowers. *See Dobson* v. *Dornan*, 118 U.S. 10, 15 (1886) (design patent for rug with, *inter alia*, "floral decorations" and "an outer zigzag stripe" is valid); *Ethicon Endo-Surgery, Inc.* v. *Covidien, Inc.*, 796 F.3d 1312, 1334 (Fed. Cir. 2015) (asserted design patents "do not protect the general design concept of an open trigger, torque knob and activation button" but rather "particular ornamental designs of those underlying elements ... [*i.e.*,] the depicted or-

namental aspects of certain combinations of the trigger, torque knob and activation button elements ... in specific relative positions and orientations"); *Lee* v. *Dayton-Hudson Corp.*, 838 F.2d 1186, 1188 (Fed. Cir. 1988) ("by obtaining a design patent, not a utility patent, Mr. Lee limited his patent protection to the ornamental design of the article"; protection did not extend to the article's "basic configuration"). Indeed, Apple identified at trial three smartphones designed by competitors that incorporate "rectangles [and] round corners" (Pet. 2) but do not infringe because their overall appearance is distinctly different from the iPhone. *See supra* p. 16 (pictures of Pantech Crossover, LG Optimus, and Sony Ericsson Experia Arc 5).[5]

Samsung raises two other doctrines (Pet. 23-24) that it believes "conflict" with the Federal Circuit's ruling. Samsung did not seriously argue such a conflict to the Federal Circuit, and for good reason—there is none.

The "filtration doctrine" of copyright law—which this Court has never adopted—applies primarily to the special context of "computer software." 4 *Nimmer on Copyright* § 13.03[F] (2015). Because copyrights are not examined by an expert agency and their content is not determined before litigation, courts use filtration to

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[5] Samsung's argument is so clearly wrong that one of its law professor amici in the Federal Circuit distanced herself from the petition for certiorari and did not join the Professors amicus brief in this Court. *See* Burstein, *Apple, Samsung & Design Patent Claim Construction*, Patently-O (Jan. 4, 2016), http://patentlyo.com/patent/2016/01/samsung-patent-construction.html (criticizing as "questionable" Samsung's "new approach to design patent claim construction" and noting that it is "not clear what would qualify as a 'conceptual' aspect (or feature) of a design" under Samsung's novel test).

identify copyrightable material. *Id.* ("[B]efore evaluating substantial similarity, it is necessary to eliminate from consideration those elements of a program that are not protected by copyright." (footnote omitted)); *cf. id.* § 13.03[A][1][d] ("granting copyright holders protection ... provided to patent holders ... could be disastrous, given that neither the safeguard of patent examination nor the *quid pro quo* of disclosure is required to receive copyright protection" (footnote omitted)). Design patents, by contrast, do not issue unless the claims survive a thorough examination by the Patent and Trademark Office and the agency determines that the claims meet the statutory requirements. *See* PTO, MPEP § 1504 ("In design patent applications, ornamentality, novelty, nonobviousness[,] enablement, and definiteness are necessary prerequisites to the grant of a patent.").[6] Moreover, as Samsung's own cited authority explains, filtration merely represents the courts' best effort to grapple with the fact that "copyright registration—with its indiscriminating availability—is not ideally suited to deal with the highly dynamic technology of computer science." *Computer Assocs. Int'l, Inc.* v. *Altai, Inc.*, 982 F.2d 693, 712 (2d Cir. 1992); *see also id.* (filtration is "the courts' attempt to fit the proverbial square peg in a round hole"). Samsung identifies no good reason to port this makeshift doctrine into patent law.

Samsung's trademark argument fares no better. This Court has clearly distinguished the tests for functionality in the trade dress and design patent contexts. *Compare TrafFix Devices, Inc.* v. *Marketing Displays, Inc.*, 532 U.S. 23, 33 (2001) (trade dress is impermissi-

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[6] http://www.uspto.gov/web/offices/pac/mpep/s1504.html (last visited Feb. 3, 2016).

bly functional "when it is essential to the use or purpose of the device or when it affects the cost or quality of the device"), *with Bonito Boats, Inc.* v. *Thunder Craft Boats, Inc.*, 489 U.S. 141, 148 (1989) (a design patent "must present an aesthetically pleasing appearance that is not dictated by function alone").[7] Imposing a more restrictive functionality standard for trade dress makes sense, because trade dress is a common-law, judge-made doctrine that provides protection for an indefinite period of time to prevent consumer confusion. *See TrafFix*, 532 U.S. at 28-29 ("caution[ing] against misuse or overextension of trade dress"). In contrast, design patents are screened by the Patent Office and provide protection only for a limited period.[8]

2. Samsung separately argues (Pet. 24-25) that the district court should have provided a more detailed verbal construction of Apple's design patent claims. Neither the statute nor any decision of this Court requires a district court to use words to explain a design more clearly conveyed by illustrations. Rather, this Court has made clear that, while a utility patent might

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[7] Amici Professors (Samsung's only amici to discuss this issue) cherry-pick language to suggest (Br. 4) that the *Federal Circuit* has "eviscerated" the functionality doctrine. In fact, the Federal Circuit's test accords with the test laid out in *Bonito Boats*. *See Ethicon*, 796 F.3d at 1328 (citing *Bonito Boats* for the proposition that "[d]esign patents" that are "'dictated by'" function—*i.e.*, "primarily functional"—are invalid). Even Samsung concedes (Pet. 24) that the Federal Circuit's functionality test is "that a design must be 'dictated by function.'"

[8] Samsung and its amici also imply that Apple's design patents should be *invalidated* under the trade dress standard of functionality. *E.g.*, Pet. 24; Professors Br. 6. But the jury found the patents valid, and Samsung did not appeal that finding. *See supra* p. 12.

be "void on its face for want of a sufficient description and claim," a design patent is valid even if all that is claimed is a "photographic illustration" without any written description. *Dobson* v *Dornan*, 118 U.S. at 12-15 (upholding design patent that explained its claim only with a "photographic illustration" of a "six-inch square" of carpet). That is because a design "is better represented by the photographic illustration than it could be by any description, and a description would probably not be intelligible without the illustration." *Id.* at 14.

This focus on the overall visual appearance of a design—as opposed to how a court's language might translate it—is equally important in the infringement analysis. This Court explained that the test is whether "in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same" such that "the resemblance is such as to deceive such an observer." *Gorham Co.* v. *White*, 81 U.S. (14 Wall.) 511, 528 (1872). In other words, a reasonable jury is not prevented from finding infringement by the "mere difference of lines in the drawing or sketch, a greater or smaller number of lines, or slight variances in configuration." *Id.* at 526-527. A contrary rule would "destroy all the protection which ... Congress intended to give. There never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another ... that an expert could not distinguish them." *Id.* at 527.

To require in all cases a verbal description of the scope of a design patent would risk diverting focus from the design's overall ornamental appearance, potentially leading the jury to focus on minor (and legally insignificant) differences. *See Egyptian Goddess, Inc.* v. *Swisa, Inc.*, 543 F.3d 665, 679-680 (Fed. Cir. 2008) (en banc)

(detailed claim construction "risks ... placing undue emphasis on particular features of the design and ... risk[s] that a finder of facts will focus on each individual described feature in the verbal description rather than on the design as a whole"). Of course, while a court may *choose* to provide a verbal description of a design patent claim, there is no reason to *require* one as a categorical matter.

Contrary to Samsung's claim, the Federal Circuit's design patent ruling does not clash with this Court's *utility patent* decisions. *See* Pet. 24-25 (citing *Markman* v. *Westview Instruments, Inc.*, 517 U.S. 370 (1996); *Teva Pharm. USA, Inc.* v. *Sandoz Inc.*, 135 S. Ct. 831 (2015)). Utility patents are directed to persons skilled in the relevant art, *Markman*, 517 U.S. at 373, and thus often require technical insight to discern their limits. Infringement of a design patent, by contrast, does not turn on how a skilled expert would interpret technical language in a written instrument, *cf. id.* at 389-390, but on whether an ordinary observer would be deceived by the accused infringer's design—an issue that a jury can often readily determine by comparing the patented design to the accused products. *See supra* pp. 16-17, 21.

Accordingly, while the en banc Federal Circuit has stated that there is a "duty to conduct claim construction," it "has not prescribed any *particular form* that the [design patent] claim construction must take." *Egyptian Goddess*, 543 F.3d at 679-680 (emphasis added). To the contrary—because of the drawbacks discussed above—"[a]s a general matter, [district] courts *should not* treat the process of [design patent] claim construction as requiring a detailed verbal description of the claimed design, as would typically be true in the case of utility patents." *Id.* at 680 (emphasis added).

While there is no *per se* rule prohibiting a "detailed verbal description of the claimed design," "the preferable course ordinarily will be for a district court not to attempt" one if the drawings are clear as to what is protected. *Id.* at 679.

Here, the district court's claim construction was amply detailed. The court instructed the jury to consider "the ornamental design" of the patents-in-suit. Pet. App. 160a-161a. The court also provided guidance on how to understand the scope of each patented design. It noted, for example, that in the D'677 patent "[t]he broken lines ... constitute unclaimed subject matter," "[t]he use of solid bl[a]ck surface shading ... represents the color black," and "[t]he use of oblique line shading ... is used to show a transparent, translucent or highly polished or reflective surface." *Id.* 161a. It also instructed the jury that the D'087 patent "claims the front face [of an electronic device], a bezel encircling the front face of the patented design that extended from the front of the phone to its sides, and a flat contour of the front face," and that the "broken line showing of a display screen" in the D'305 patent "forms no part of the claimed design." *Id.* Samsung has shown no statute or decision of this Court requiring any more than that.

B. This Case Is A Poor Vehicle To Address Design Patent Infringement In Any Event

Certiorari is independently unwarranted because this case is a poor vehicle for both of Samsung's challenges to infringement.

As for Samsung's first argument regarding the treatment of "functionality" in the jury instructions, Samsung is strategically vague as to whether it be-

lieves that the district court should have instructed the jury to exclude functional features or should have done so itself. Both options undermine Samsung's argument. If Samsung wants this Court to hold that a *jury* should construe the patent to eliminate functional features (*see* Pet. 22), that is directly contrary to the principles espoused in *Markman* with respect to construction of utility patents and accordingly undermines Samsung's already tenuous claim of conflict with this Court's precedent. *See supra* pp. 20-23. Moreover, the jury *did* consider—and rejected—Samsung's assertion that Apple's design patents were invalid because they were dictated by function.

If Samsung means that the district court should itself have construed the claims to exclude functional features (*see* Pet. 22), that argument founders on the district court's conclusion—unchallenged on appeal—that no design element identified by Samsung was dictated by function. *See* Pet. App. 60a-61a; Apple C.A. Br. 31; *see also* Pet. 24 (district court found that "'Samsung had not shown'" that any elements were dictated by function).

This case is also a poor vehicle for Samsung's second argument—that the district court failed to provide sufficient verbal claim construction. As shown above, the district court gave the jury ample guidance. *See supra* p. 23. Moreover, Samsung did not raise the issue on appeal until a short paragraph in its reply brief. Samsung C.A. Corrected Reply Br. 3-4. The issue was accordingly waived; at the very least, the Federal Circuit panel lacked full briefing on the point. *See Advanced Magnetic Closures, Inc.* v. *Rome Fastener Corp.*, 607 F.3d 817, 833 (Fed. Cir. 2010). Unsurprisingly, the Federal Circuit panel did not address the issue in its opinion, which further cuts against granting certi-

orari. *E.g.*, *Meyer* v. *Holley*, 537 U.S. 280, 291 (2003) ("[I]n the absence of consideration of that matter by the Court of Appeals, we shall not consider it."); *NCAA* v. *Smith*, 525 U.S. 459, 470 (1999) ("[W]e do not decide in the first instance issues not decided below.").

II. THE FEDERAL CIRCUIT'S RULING ON DESIGN PATENT DAMAGES DOES NOT MERIT THIS COURT'S REVIEW

A. The Federal Circuit's Ruling Is Fully Consistent With § 289's Text, Legislative History, And Longstanding Judicial Interpretation

35 U.S.C. § 289 could not be clearer. Its title is an "[a]dditional remedy for infringement of [a] design patent," and it provides that the infringer of a design patent "shall be liable ... to the extent of his total profit." The Federal Circuit thus unremarkably held that § 289's text "explicitly authorizes the award of total profit from the [infringing] article of manufacture bearing the patented design." Pet. App. 28a; *see also Bergstrom* v. *Sears, Roebuck & Co.*, 496 F. Supp. 476, 495 (D. Minn. 1980) ("[I]t is unlikely that Congress would have used such all encompassing language if it intended that a design patentee could only recover profits attributable solely to the design or ornamental qualities of the patented article.").

This straightforward reading of § 289—that "total profit" means "total profit" and not "some profit"—is well supported by the statute's history and purpose. As the Federal Circuit explained in 1998, design patent holders asserting infringement before 1887 "could recover only the proportionate amounts [of profits] that were proven to be attributable to the patented feature." *Nike, Inc.* v. *Wal-Mart Stores, Inc.*, 138 F.3d 1437, 1441 (Fed. Cir. 1998). The remedy's inadequacy became apparent in the *Dobson* cases, where this Court

held several carpet design patents infringed, but awarded only six cents in damages "because the patentees could not show what portion of their losses or the infringers' profits was due to the ... unpatented carpet." *Id.* (discussing *Dobson* v. *Dornan*, 118 U.S. 10 (1886); *Dobson* v. *Hartford Carpet Co.*, 114 U.S. 439 (1885); *Dobson* v. *Bigelow Carpet Co.*, 114 U.S. 439 (1885)).

Congress overruled the *Dobson* decisions in relevant part by enacting the Design Patent Act of 1887, which created a special "rule of recovery for design patents" because "[i]t is expedient that the *infringer's entire profit* ... should be recoverable, as otherwise none of his profit can be recovered, *for it is not apportionable.*" 18 Cong. Rec. 834 (1887) (emphases added); *see supra* p. 5.[9]

The Federal Circuit's application of § 289 in this case broke no new ground. Eighteen years ago, the Federal Circuit's *Nike* decision observed that § 289's predecessor was "specific to design patents[and] removed the apportionment requirement." 138 F.3d at 1441. The Federal Circuit thus held that Wal-Mart was required to pay Nike its *pre*-tax (rather than *post*-tax) profits from infringement. *Id.* at 1448 ("The statute requires *the disgorgement of the infringers' profits* to the patent holder, such that the infringers retain no profit

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[9] Samsung selectively quotes the House Committee Report's passing statement that the 1887 Act's effect was "to give [consumers] more beautiful carpets and wall-papers and oil-cloths for the same money," 18 Cong. Rec. 834, and seeks to extrapolate a rule that § 289 only applies to "*single undifferentiated* article[s] of manufacture." Pet. 34; *see also* Google Br. 9-10. No such limitation appears in the statute and, in any event, the Federal Circuit ruled that Samsung's smartphone designs were not "distinct" from the phones' internal workings, Pet. App. 29a.

from their wrong." (emphasis added)). *Nike* was merely one in an unbroken line of cases, including several predating the creation of the Federal Circuit, that applied § 289 just as the courts below did here. *See, e.g.*, *Trans-World Mfg. Corp.* v. *Al Nyman & Sons, Inc.*, 750 F.2d 1552, 1567 (Fed. Cir. 1984) (section 289 overturned the *Dobson* rule that "an apportionment was required"); *Schnadig Corp.* v. *Gaines Mfg. Co.*, 620 F.2d 1166, 1171 (6th Cir. 1980) ("'[t]he patent law gives the right to recover all profits from an infringement'" of a design patent); *Henry Hanger & Display Fixture Corp. of Am.* v. *Sel-O-Rak Corp.*, 270 F.2d 635, 643-644 (5th Cir. 1959) ("Profits of the [design patent] infringer are evidence of the damages sustained by the holder of the patent and may be the measure of damages."). Although the Federal Circuit relied on these holdings, Pet. App. 28a, Samsung remarkably does not discuss them.

Congress has declined opportunities to modify this remedy for design patent infringement. "In 1946, Congress abolished the recovery of infringer profits for infringement of *utility patents* but left unchanged the special 'total profit' provision for design patents." 7 *Chisum on Patents* § 20.03[5] (emphasis added). And in 1952, Congress changed the wording of § 289 to eliminate a knowledge requirement, but kept the total profit remedy intact. *Nike*, 138 F.3d at 1442.

Contrary to Samsung's repeated and misleading implication (Pet. 19, 26, 27, 31, 32), the Federal Circuit did not agree with Samsung's amici's assertions that the statute's plain text produced "'absurd'" results or "'makes no sense in the modern world.'" Rather, the panel properly declined to consider "policy arguments that should be directed to Congress." Pet. App. 28a n.1; *see infra* p. 37. Besides, there is nothing absurd about an award of infringers' profits in this case—as Con-

gress recognized, it is exceedingly difficult to apportion the harm caused by blatant copying of a patented design. *See supra* pp. 5, 26. Indeed, several of Samsung's own amici before the Federal Circuit acknowledged that failing to award Apple "Samsung's entire profits" would have been "wrong as a matter of law." *E.g.*, Lemley, *A Rational System of Design Patent Remedies*, 17 Stan. Tech. L. Rev. 219, 220-221 & n.3 (2013).[10]

B. Samsung Identifies No Reason To Depart From § 289's Clear And Settled Meaning

1. There is no circuit split

Samsung fails to identify any case from this Court suggesting that a statute like § 289 should be read to mean the exact opposite of what it says. Nor does Samsung acknowledge that the courts of appeals have consistently followed the very interpretation of § 289 applied below. *See supra* pp. 26-27.

Instead, Samsung tries (Pet. 27-32) to generate uncertainty by focusing on isolated phrases taken out of context. Samsung argues that the requirement in the second paragraph of § 289 that the patent holder "shall not twice recover the profit *made from* the infringement" imposes an apportionment requirement. Pet. 30-32 (emphasis added). No court has adopted this inter-

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[10] *See also* Cotter, Apple v. Samsung *and Awards of Defendants' Profits*, intellectualIP (Aug. 29, 2012), http://intellectualip.com/2012/08/29/apple-v-samsung-and-awards-of-defendants-profits-the-potentially-for-overcompensatory-damages-in-design-patent-infringement-cases/ (jury's award "is permissible under design patent law"); Risch, *Functionality and Graphical User Interface Design Patents*, 17 Stan. Tech. L. Rev. 53, 60 (2013) ("[D]esign patents allow for much greater damages [than copyright]: *all* of the defendant's profits.").

pretation. The House Committee Report explained that the second paragraph simply "save[s] all the rights of defendants against any possible double recovery for the same infringement." 18 Cong. Rec. 834; *see also Catalina Lighting, Inc.* v. *Lamps Plus, Inc.*, 295 F.3d 1277, 1291 (Fed. Cir. 2002) (this language "'insure[s] that a patentee [can]not recover both the profit of an infringer and some additional damage remedy from the same infringer, such as a reasonable royalty'").[11]

Samsung also argues (Pet. 27-29) that the term "article of manufacture" should be read narrowly to mean the specific "*portion* of a product to which the patented design is applied." But it provides no reason why Congress would have contradicted its own clear statutory language about "total profit"—and the House Committee Report's analysis—in such a backhanded manner. *See supra* pp. 25-26; *Bilski* v. *Kappos*, 561 U.S. 593, 645 (2010) (Stevens, J., concurring) ("Congress 'does not, one might say, hide elephants in mouseholes.'").[12]

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[11] Amici's assertion (Professors Br. 17) that deletion of a phrase from the 1887 Act "suggests" an intent to impose a causation requirement is unavailing. Section 289 is a "consolidation of two sections of the old statute," which unsurprisingly required "some revision in language." Federico, *Commentary on the New Patent Act*, 75 J. Pat. & Trademark Off. Soc'y 161, 203 (1993). When Congress intends to change a statute's well-established meaning, it makes such intent "explicit in the statute, or at least ... mention[s] it at some point in the ... legislative history." *Chisom* v. *Roemer*, 501 U.S. 380, 396 (1991). Congress did neither here.

[12] CCIA ventures (Br. 8-10) that the term "article of manufacture" should be read in light of the 1998 Vessel Hull Design Protection Act, but provides no reason why the 1887 Congress's intent can be discerned from a very different (and "*sui generis*") law enacted well over a century later.

Samsung cites two cases from the Second Circuit—*Bush & Lane Piano Co.* v. *Becker Bros.*, 222 F. 902 (2d Cir. 1915), and *Bush & Lane Piano Co.* v. *Becker Bros.*, 234 F. 79 (2d Cir. 1916). But those hundred-year-old cases involved a very different factual situation. *See* Pet. App. 29a. The patentee sought to recover damages on two related, but analytically distinct, items—a piano and a piano case—where the design patent covered only the piano case. The Second Circuit's rejection of the patentee's claim is explained by the fact that a customer in 1915 could "have [a] piano placed in any one of several cases," such that the piano was not part of the infringing product. *See Bush & Lane*, 222 F. at 903.[13] By contrast, Apple's and Samsung's customers cannot select the smartphone casing or user interface separately from the smartphone. Pet. App. 29a ("The innards of Samsung's smartphones were not sold separately from their shells as distinct articles of manufacture to ordinary purchasers."). Rather, the iPhone's sleek, minimalist body (D'087 and D'677) and its brightly colored user interface (D'305) are what people envision when they think of the iPhone. CAJA24904-24905, 25173-25174, 25261; *see also supra* pp. 5-6. Indeed, even the 1915 *Bush & Lane* opinion agreed that, had the piano case been "inseparable from the article to which it is attached, or of which it is a part," it would be

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[13] While the Second Circuit noted in the 1916 *Bush & Lane* case that the 1915 opinion incorrectly stated that there were "*separate market[s]*" for a piano mechanism and a piano case, 234 F. at 83 (emphasis added), whether they were sold in a separate "market" does not change that they were separate *items*. Accordingly, Samsung is incorrect that the Second Circuit "expressly rejected" the notion that "'a piano and a piano case a[re] distinct articles of manufacture.'" Pet. 29 (quoting Pet. App. 29a).

"justice" to give the patentee "the entire profits made by the sale of the article." 222 F at 904.

Moreover, it is not clear that the *Bush & Lane* cases are good law even in the Second Circuit. They conflict directly with the Second Circuit's prior decision in *Untermeyer* v. *Freund*, 58 F. 205 (2d Cir. 1893), which held that § 289's predecessor permitted an award of "the *total profit* from the manufacture or sale of the article to which the [patented] design was applied, as distinguished from the pre-existing rule of the profit which could be proved to be attributable to the design." *Id.* at 212 (emphasis added); *see also Bush & Lane*, 222 F. at 905-906 (Ward, J. dissenting) (acknowledging this conflict); *United States* v. *Snow*, 462 F.3d 55, 65 n.11 (2d Cir. 2006) ("[A] prior decision of a panel of this court binds all subsequent panels.'"). Indeed, the Second Circuit openly acknowledged that it was engaging in "apportion[ment]," *Bush & Lane*, 234 F. at 83, which is contrary to the statute's text and purpose, *see supra* pp. 25-28.

Young v. *Grand Rapids Refrigerator Co.*, 268 F. 966 (6th Cir. 1920), is also factually inapposite. There, the patentee did not even "seriously contend[] that all the profits from the refrigerator belonged to" him. *Id.* at 974-975. That concession made sense because the case involved the design of a *de minimis* portion of a refrigerator—a single latch. *Id.* In contrast, Apple's patents protect the overall look-and-feel of the iPhone, which is in no way *de minimis*. *See supra* pp. 5-6.

Finally, Samsung's citation to *In re Zahn*, 617 F.2d 261 (C.C.P.A. 1980), only reveals how little authority Samsung has for its position. Samsung did not cite *Zahn* to the Federal Circuit at any point, doubtless be-

cause *Zahn* involved a question of patent validity, not the remedy available under § 289. *Id.* at 267-268.

2. Samsung's analogies to other legal contexts are inapt

Samsung also attempts to impose the apportionment requirement rejected by Congress and the courts of appeals by arguing that § 289 conflicts with damages remedies in other legal contexts. Pet. 30-34 (invoking, *inter alia*, utility patents, copyright, securities law, RICO, and the Violence Against Women Act); *see also* Google Br. 14-15 (analogizing to utility patent doctrines); Professors Br. 13-14 (same). But remedies governed by *different* statutory provisions or the common law cannot justify disregarding § 289's plain language and clear legislative history.

To take just one example, Samsung claims (Pet. 31) that *Sheldon* v. *Metro-Goldwyn Pictures Corp.*, 309 U.S. 390 (1940), interpreted "similar language" in the 1909 Copyright Act to impose a causation requirement. But the statutory language is in fact quite different. The 1909 Copyright Act states that an infringer is liable

> "[t]o pay to the copyright proprietor such damages as the copyright proprietor may have suffered due to the infringement, *as well as all the profits which the infringer shall have made from such infringement.*"

Sheldon, 309 U.S. at 399 (emphasis added). In contrast, § 289 entitles the patentee to the infringer's total profit without the Copyright Act's immediate qualification that the plaintiff is entitled only to the "profits … made from such infringement":

> Whoever during the term of a patent for a design, ... applies the patented design or any colorable imitation thereof, to any article of manufacture for the purposes of sale ... *shall be liable to the owner to the extent of his total profit, but not less than $250*, recoverable in any United States district court having jurisdiction of the parties.

(Emphasis added.) In making the comparison to *Sheldon*, Samsung focuses (Pet. 31) on language at the tail end of the second paragraph of § 289, but, as discussed above, this language merely prohibits double recovery. *See supra* pp. 28-29.[14]

Samsung argues in passing that the Federal Circuit's ruling creates "serious constitutional questions." Pet. 38-39; *see also* CCIA Br. 5-7. They were apparently not serious enough to warrant inclusion in Samsung's petition for rehearing or motion to stay the mandate. *See* C.A. Dkts. 159, 208. And rightly so—the Federal Circuit's ruling did not suddenly "'enlarge'[]" the patent monopoly. *See* Pet. 38. It merely held that the jury *was entitled* (not required) to award Samsung's total profits on smartphones that copy the patented and valuable look-and-feel of the iconic iPhone. *See supra* p. 12. *Graham* v. *John Deere Co.*, 383 U.S. 1, 3 (1966), is

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[14] *Sheldon* also relied heavily on the fact that the infringer's profits remedy for *utility* patents required apportionment. 309 U.S. at 399-404. The legislative history for the Copyright Act not only had "no suggestion that Congress intended that the award of profits should be governed by a different principle in copyright cases [compared to utility patent cases,] but the contrary is clearly indicated by the committee reports on the bill." *Id.* at 400. As shown above, however, § 289 and its legislative history make crystal clear that Congress's remedies for design patent infringement are *different* from utility patent remedies. *See supra* pp. 25-26.

thus inapposite—it speaks to constitutional limitations on patentability, not limits on *remedies*.

III. This Case Does Not Present An Important Question Requiring This Court's Resolution

Samsung's insistence (Pet. 35) that the rulings challenged in its petition create a "sea change in the law" is a vast misstatement. The Federal Circuit's decision simply carries forward well-established principles of over a century of precedent, applied to the particular facts and circumstances of this record. *See supra* pp. 13-23, 25-28.

Samsung's sea-change assertion relies largely on speculative policy arguments, such as its warning that the Federal Circuit's ruling would "*require*" an award of total profits for a truck based on an infringing cupholder. *See* Pet. 31-32 (emphasis added); *see also, e.g.*, Public Knowledge Br. 2. But an award of total profits is a *ceiling* on the jury verdict, not a floor. As the district court instructed the jury, § 289 merely gives the *option* to award total profit. Pet. App. 165a ("If you find infringement by any Samsung Defendant and do not find Apple's design patents are invalid, you *may* award Apple that Samsung defendant's total profit ...." (emphasis added)). Moreover, this case is not remotely comparable to Samsung's extreme hypotheticals. Apple's design patents do not cover a minor component of the iPhone; they cover the overall appearance of the device's distinctive front face, bezel, and graphical user interface—in other words, the iconic look and feel of Apple's iPhone. *See supra* p. 6; Apple C.A. Br. 7-9 (illustrations of Apple's design patents).[15]

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[15] Public Knowledge premises its brief on the mistaken assumption that the Federal Circuit's ruling *requires* a jury that

Samsung also claims (Pet. 32) that the Federal Circuit's ruling would "allow multiple recoveries of a manufacturer's profits," but that is abstract speculation about an issue not present in this case. Indeed, Samsung fails to identify *any* case where this supposed problem has arisen. If it did, the infringer could always avoid multiple recovery through established mechanisms such as impleader, as one of Samsung's own amici has explained. *See* Lemley, 17 Stan. Tech. L. Rev. at 231.

Finally, Samsung threatens (Pet. 36-37) that the Federal Circuit's decision encourages design "patent trolls." Once again, Samsung fails to identify even a single example supporting its alarmist hypothetical. Unlike in the utility patent world, where non-practicing patent assertion entities are numerous, Samsung cannot name one entity with a valid design patent that has reaped undeserved rewards by leveraging the inter-

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finds design patent infringement to award total profit, but fails to identify any such holding in the opinion below.

Amicus Systems' self-interested arguments about the scope of § 289 emphasize a different decision by a later Federal Circuit panel and thus have little relevance to whether certiorari should be granted in this case. *See* Systems Br. 6-7 (discussing Systems' loss in recent Federal Circuit decision); *see also Nordock, Inc.* v. *Systems, Inc.*, 803 F.3d 1344, 1354 (Fed. Cir. 2015) ("'Section 289 explicitly *authorizes* the award of total profit ....'" (emphasis added)). And Google's submission should be viewed with particular skepticism, as Google is not a neutral third party: "Google is the developer of Android, a platform for mobile devices such as smartphones and tablet computers, and *particular versions of Android running on the Samsung products that are the subject of the Order*." Google Mot. for Leave to File Brief 4, Dkt. 55, No. 2013-1129, *Apple Inc.* v. *Samsung Elecs. Co.* (Fed. Cir. May 6, 2013) (emphasis added); *see also* Pet. 9 (Samsung uses "Google's Android operating system for its flagship products").

pretation of § 289 that has been on the books since at least the 1998 *Nike* decision.

While Samsung and its amici reference district court cases where § 289 has been invoked, all three involve disputes between competitors, not between a non-practicing entity and a legitimate business. *See Pacific Coast Marine Windshields Ltd.* v. *Malibu Boats, LLC*, 2014 WL 4185297, at *1-3 (M.D. Fla. Aug. 22, 2014); Compl. 1-2, 10, Dkt. 1, No. 14-cv-7009, *Skechers U.S.A., Inc.* v. *DB Shoe Co.* (C.D. Cal. Sept. 8, 2014); Compl. 1, Dkt. 1, No. 15-cv-5836, *Microsoft Corp.* v. *Corel Corp.* (N.D. Cal. Dec. 18, 2015). Even the source Samsung cites (Pet. 37-38) for its claim that non-practicing entities "have already seized on the [Federal Circuit's] decision to demand sizeable payments" is a blog post that discusses a questionable demand letter premised on a "'*pending*'"—*i.e.*, as yet unissued—"'design patent portfolio.'" Macri, *Patent Trolls Are Already Abusing the* Apple v. Samsung *Ruling*, InsideSources (Oct. 1, 2015) (noting that the portfolio "list[s] a series of functionalities patented under a *utility* patent ... that doesn't belong" to the author of the demand letter (emphasis added)).[16] Tellingly, Samsung's amici can do no better—they invoke the same underlying example. Google Br. 17; CCIA Br. 12; Public Knowledge Br. 8.

The lack of concrete instances of "design patent trolls" is unsurprising. Patent trolls may succeed in anticipating technological features and acquiring corresponding *utility* patents, but it is much harder to anticipate product *designs* before they are released—

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[16] http://www.insidesources.com/patent-trolls-are-already-abusing-the-apple-v-samsung-ruling/.

particularly given that innovative design companies typically give their products a unique look to differentiate their brand. Even if a troll anticipated what design patents might prove lucrative, it would be highly unusual for a design innovator to sell, assign, or license design rights to a troll. While a company might monetize unused utility patents through sale or license, it will typically keep its design rights to avoid giving away control of its brand.[17]

Even if Samsung's doomsday warnings were well-founded (though that is highly doubtful), such policy considerations are best addressed by Congress. Pet. App. 28a n.1; *see also, e.g.*, *Microsoft Corp.* v. *AT&T Corp.*, 550 U.S. 437, 458-459 (2007) ("If the patent law is to be adjusted ..., the alteration should be made after focused legislative consideration, and not by the Judiciary ...."). Ultimately, "[i]t is for Congress to determine if the present system of design and utility patents is ineffectual." *Bonito Boats*, 489 U.S. at 167-168.

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Samsung had its day in court—many days, in fact—and the properly instructed jury was well-justified in finding that Samsung copied Apple's designs and should pay the damages that the statute expressly authorizes. While this litigation may be high-profile, it is legally unexceptional, and Samsung has shown no reason for this Court to prolong it.

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[17] Apple is particularly protective of its design rights and would never license them to enable a competitor to manufacture a cloned smartphone. CAJA41961-41963 (Apple "strongly desire[s] not to license" the "unique user experience" portion of its portfolio, which includes its design patents).

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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